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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT ANTHONY MARIN,
LARRY R. MARSHALL, and
BARBARA K. O'ROURKE

Appeal 2006-2877
Application 09/691,273
Technology Center 1700

Decided: March 18, 2008

Before CHUNG K. PAK, THOMAS A. WALTZ, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON REQUEST FOR HEARING

1 Appellants request rehearing of our Decision of October 11, 2007.
In that Decision, we affirmed the Examiner's decision to reject claims 2-4,
7-18, and 21-30 under 35 U.S.C. § 103(a).

Appellants contend we failed to:

(1) completely comprehend and/or address the issues raised by Appellants with respect to the failure of the combination of Harriss et al. and Blades to establish a *prima facie* case of obviousness;

(2) properly apply the law of In re Oelrich as to inherency; and

(3) fully understand the nature of the comparative testing discussed at length in Appellants' Appeal and Reply Briefs.

(Request 2).

Appellants have not persuaded us of reversible error in our Decision for the following reasons.

The claims at issue, claims 28, 29, and 30, are directed to products.

Claim 28 is directed to a polyethylene plexifilamentary fiber strand. Claims 29 and 30 are directed to nonwoven sheets produced from the fiber strands. Each of the claims recite process limitations as well as property limitations.

As evidence of unpatentability, the Examiner cited to page 17, lines 23-35 of Harriss, a portion of Harriss discussing Comparative Example 1, finding that Harriss describes a plexifilamentary sheet, i.e., a nonwoven produced from plexifilamentary fiber strands (Ans. 4). The Examiner acknowledged that Harriss spins the fibers at a temperature outside the range recited in the claims (lower than the claimed range), and relied on Blades, finding that the claimed spinning temperature was known in the art as exemplified by Blades (Ans. 4-5). The Examiner concluded that it would have been obvious to one of ordinary skill in the art to increase the spinning temperature in the process of Harriss as taught by Blades, and that it is reasonable to presume that the claimed properties would result (Ans. 5).

Appellants, in response, contended that Blades was improperly combined with Harriss (Br. 5-8). Appellants also relied upon comparisons of Harriss' Comparative Example 1 with Appellants' Comparative Example B as well as their Table 3 as providing evidence that their fibers and non-wovens are different from those of Harriss' Comparative Example 1 (Br. 9-11).

Two issues arose from the contentions of Appellants.

The first issue arose from Appellants' contention that Blades was improperly combined with Harriss. This gave rise to the issue: Does Blades, as applied by the Examiner, support the Examiner's finding that the claimed spinning temperature was known in the art?

The second issue arose from the Examiner's reliance on Harriss' Comparative Example 1 to support the rejection and Appellants' response in which they compared results from their Specification examples with the results of Harriss' Comparative Example 1. This second issue was: Was it reasonable to presume that fiber strands and nonwovens made in accordance with Comparative Example 1 of Harriss would inherently have properties recited in the claim such that the burden shifted to Appellants to show that the claimed properties are, in fact, not obtained, and, if so, have Appellants met their burden in showing there is a patentable difference in properties?

1. The Combination of Harris and Blades

Appellants now request that “[i]f the Board agrees that Blades is not combinable with Harriss et al., Appellants respectfully request that the Board so state.” (Request 3).

The question of whether Blades was properly combined with Harriss is not a dispositive issue in this appeal. This is because under the law, the

prior art need not affirmatively teach a process limitation contained in a product claim where the evidence reasonably supports a conclusion that the products are the same or substantially the same notwithstanding the processing difference, and Blades is relied upon by the Examiner merely to meet the process limitation of spinning temperature. As we stated in our Decision:

It has long been held that "[i]f the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1317, 78 USPQ2d 1097, 1101 (Fed. Cir. 2006) (quoting *In re Thorpe*, 777 F.2d 695, [697], 227 USPQ 964, 966 (Fed. Cir. 1985)). Therefore, the temperature at which the fibers are made is only relevant in so far as it affects the end product structure and properties.

(Decision 4). The answer to Appellants' question is not dispositive of the appeal. For that reason we need not decide whether the combination was proper.

However, Appellants have requested that we address the issue. In this regard, we simply say that the temperatures relied upon by the Examiner, i.e., the temperatures disclosed in Table IV of Blades for spinning in methylene chloride, are not shown to be particularly relevant to the question of what temperatures those of ordinary skill in the art would select for spinning in other conventional solutions such as the claimed normal pentane/cyclopentane mixture. That is not to say that those of ordinary skill in the art would not select those temperatures, it is only to say that such selection would arise out of routine experimentation by the ordinary artisan seeking to determine optimal or workable temperatures, rather than from the

disclosure of temperatures used for spinning in methylene chloride as disclosed in Blades' Table IV. *See In re Boesch*, 617 F.2d 272, 276 (CCPA 1980) ("[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art."); *see also In re Aller*, 220 F.2d 454, 456 (CCPA 1955) ("where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.").

2. Inherency

Turning to Appellants' second contention, i.e., that we failed to properly apply the law of *In re Oelrich*, Appellants are stating that we erred as a matter of law. We disagree.

The facts of this case differ from those of *Oelrich* and our decision is not in conflict with the law of that case.

In *Oelrich*, the claim at issue included a means plus function clause and the court determined that the function constituted a limiting definition of the means. *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981). Rather than teaching the function, the prior art expressly taught a different function, i.e., it taught a device adapted to receive a carrier frequency substantially in excess of the particular system critical or resonant frequency whereas the claim required a means for generating a carrier frequency less than the minimum system resonant frequency. Based on this fact, the court determined that the claimed function was not "inevitably present" such inevitability being required for inherency. *Oelrich*, at 582.

Oelrich relied upon the principle of law as stated in *Hansgirg v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939) which is as follows:

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. (Citations omitted.) If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Here, we are not presented with a means plus function clause, nor are we presented with a reference expressly teaching a function different from a function in the claim. We are instead presented with Harriss, a reference teaching products that reasonably appear to be the same or substantially the same as the claimed products based on similarities in the starting materials and processing. Harriss describes an example with specific processing parameters. Following those processing parameters will result in the manufacture of a product with specific properties although Harriss does not report those properties. The present case is not one of “probabilities and possibilities,” where following the process might in some cases result in the claimed properties but might not result in those properties in other cases; it is a case in which operating as taught will naturally result in specific properties although the values of those properties are not stated in the reference. Under these circumstances, as we stated in our Decision, the law counsels that:

In a case such as this where patentability rests upon a property of the claimed material not disclosed within the art, the PTO has no reasonable method of determining whether there is, in fact, a patentable difference between the prior art materials and the claimed material. Therefore, where the claimed and prior art products are identical or substantially identical, or are

produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily possess the characteristics of his claimed product. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

(Decision 8).

We are not persuaded that we made a reversible error with respect to the law of inherency.

Appellants do not contend that we made any error in fact finding. Based on those findings of fact, we found that the similarities in starting materials and processing supported a reasonable factual conclusion that the products of Harriss' Comparative Example 1 would have properties lying within the claimed ranges such that it was reasonable to shift the burden to Appellants to show that the products, are, in fact, patentably different.

While Appellants contend that our approach was error (Request 5), *Best* supports our approach to the question of inherency. Appellants are in the best position to perform the experiments required to determine the properties. This is especially true here where the Harriss patent and this application are subject to assignment to the same assignee: E. I. du Dupont de Nemours.

Appellants request clarification as to whether Blades has any relevance to the rejection (Request 4). Blades provides some background information with regard to the knowledge of those in the art. However, in the context of the present appeal, it is the product of Comparative Example 1 of Harriss which Appellants must show does not inherently possess the claimed properties.

3. Nature of the Comparative Testing

Appellants further contend that we failed to fully understand the nature of the comparative testing they discussed in the Brief and Reply Brief (Request 1 and 5-9).

Appellants have not persuaded us that we reversibly erred in considering their comparative showing.

Appellants contend that it is not reasonable to expect that Harriss' Comparative Example 1 would necessarily result in products having properties within the claimed ranges. Appellants rely upon their own Comparative Example B as evidence. According to Appellants, their Comparative Example B was run under conditions closer to those of the present examples than was Harriss' Comparative Example 1, but their Comparative Example B still does not produce a product having the claimed properties (Request 5-6).

We emphasize that the burden is on Appellants to show that, in fact, there is a patentable difference between their product and the prior art product, i.e., the product of Harriss' Comparative Example 1. Appellants are relying upon an inference that because their Comparative Example, run at 190 °C, is closer in temperature than Harriss' Comparative Example 1, run at 185 °C, it is closer to the claimed invention. The evidence, however, does not show that each and every processing parameter that differs between the two processes is neutral in terms of its effect on product properties. In fact, Appellants themselves state that “[t]hose skilled in the flash spinning art are well-aware of the inter-relationship between the numerous parameters of the process and the inability to completely predict what effects changes in even one of such parameters might have on the end product.” (Br. 7). In the

face of that unpredictability and the unpredictability shown in Appellants' own data presented in the Specification, we cannot say that Appellants have provided the level of objective evidence sufficient to meet their burden of showing that the product of Comparative Example 1 of Harriss does not, in fact, have the properties Appellants claim. The level of unpredictability also supports the reasonable nature of the burden shift.

Appellants also rely upon their Comparative Example A as demonstrating the differences between Harriss' Comparative Example nonwoven, an area bonded product, and the nonwovens of claims 29 and 30. Again, the processing parameters of Comparative Example A are different from those of Harriss' Comparative Example 1. Appellants have not established through objective evidence that the air permeability properties are, in fact, different, and the evidence is not sufficient to establish that it is unreasonable to conclude that the nonwoven of Harris' Comparative Example 1 would have the claimed properties. We cannot agree that Appellants have met their burden in showing a patentable difference.

Appellants newly direct our attention to Comparative Example C (Request 8). Appellants do not rely upon this example in their briefs, and we, therefore, will not consider it at this time. 37 C.F.R. § 41.52 (2007).

Appellants have not convinced us of a reversible error in our decision.

Appeal 2006-2877
Application 09/691,273

IV. DECISION

Appellants request for rehearing is denied.

DENIED

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